

REMARKS

This responds to the Office Action mailed July 17, 2008. Applicants respectfully request reconsideration of the application in view of the following remarks submitted in support thereof.

§101 Rejection of the Claims

Claim 52 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action asserts that “[b]ased on Supreme Court precedent, a method/process claim *must* (1) be tied to another statutory class of invention ... or (2) transform underlying subject matter (such as an article or materials) to a different state or thing” (see Office Action mailed on July 17th, 2008 at page 2). The Applicants respectfully assert that the Supreme Court never mandated such requirements and instead, noted that “[t]ransformation and reduction of an article ‘to a different state or thing’” is merely a “*clue* to the patentability of a process claim.” *Gottschalk v. Benson*, 409 U.S. at 70, (1972). In reference to M.P.E.P. 2106,

a physical transformation ‘is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application. *AT&T*, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If USPTO personnel determine that the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine it produces *a useful, tangible, and concrete result*. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved by the claimed invention is ‘useful, tangible, and concrete.’

The method recited in independent claim 52 is for a practical application of “transmitting a program containing content” and thereby produces a useful result. The practical application of “transmitting a program containing content” also produces a real-world result with “transmitting a program signal,” and is therefore tangible, that is substantially repeatable and therefore is also concrete. In view of the incorrect application of law and that the method recited in independent claim 52 produces a useful, tangible, and concrete result, the Applicants submit that the claimed invention is directed to statutory subject matter and request the 35 U.S.C. §101 rejection to be withdrawn.

§102 Rejection of the Claims

Claims 1-16, 26-34, 52-57, 61-65, and 198 stand rejected under 35 U.S.C. § 102(e) for anticipation by U.S. Patent Publication No. US 2005/0210502 to Flickinger et al. (hereinafter "Flickinger"). For the reasons explained below, the Applicants respectfully assert that Flickinger fails to identically disclose each and every feature specified in independent claims 1, 26, and 52.

Independent claims 1, 26, and 52 recite, in part, "a programming signal that comprises, a portion of the plurality of background media objects to be presented at an instance in the program to the at least two user audiences (or at least two user profiles), and a portion of the plurality of targeted media objects to be presented at the instance in the program, the portion of the plurality of targeted media objects including a first media object to be targeted to a first user audience (or a first user profile) and a second media object to be targeted to a second user audience (or a second user profile)."

In response to the amendment mailed on April 9th, 2008, the Office Action stated that Flickinger "does not teach 'background media objects to be presented at an instance in the program' and 'target media objects to be presented at the same instance in the program'" because Flickinger "teaches selecting ads to insert into a portion of the screen (i.e. background images) during an actual programming, where said ads are targeted (i.e. 'targeted media objects') based upon user's profile and where different ads may be maintained for each potential subscriber at the subscriber location (i.e. 'mother, father, child' ...)" (Office Action mailed on July 17th, 2008 at page 11). The Applicants respectfully traverse the Office Action's characterization of Flickinger relative to independent claims 1, 26, and 52 because the portion of Flickinger relied upon by the Office Action (¶ 64) does not disclose "a programming signal that comprises ... a portion of the plurality of targeted media objects to be presented at instance in the program" that includes "a first media object to be targeted to a first user audience (or a first user profile) and a second media object to be targeted to a second user audience (or a second user profile)," as recited in independent claims 1, 26, and 52.

In particular, Flickinger discloses that "[i]t may also be applied to insert ads in the electronic program guides (EPGs) that are frequently provided in one channel of television programming and which commonly include ads in a portion of the display" (¶ 41). As disclosed in paragraph 64 and noted by the Office Action, the "STB 200 maintains multiple ads and

executes a subscriber (viewer) determination algorithm for selecting which ad to retrieve based on predetermined criteria. For instance, a different ad may be maintained for each potential subscriber (television viewer) at the subscriber location (e.g., mother, father, child).” However, as discussed in the previous response mailed on April 9th, 2008, Flickinger further discloses an “information stream includes *particular time intervals* which are dedicated for insertion of such external data” (§ 41). Accordingly, the “subscriber will receive the designated ads in the *designated order* as avails [or intervals] occur in whatever programming he or she is viewing” (§ 45). Flickinger therefore discloses that an advertisement is “inserted into that avail [or interval] (i.e., substituted for the default ad)” at “particular time intervals” and in “designated order” (§ 41, 42 and 45). The advertisements, as disclosed in Flickinger, are therefore received sequentially and multiple advertisements are not and **cannot** be viewed together at the same time. That is, for example, an advertisement intended for a mother cannot be inserted together with another advertisement intended for a father at the same time interval.

In contrast, independent claims 1, 26, and 52 recite “a programming signal that comprises ... a portion of the plurality of targeted media objects *to be presented at instance in the program*” that includes “*a first media object* to be targeted to a first user audience (or a first user profile) and *a second media object* to be targeted to a second user audience (or a second user profile).” As Flickinger merely discloses advertisement that are inserted at particular time intervals and in designated order, Flickinger cannot reasonably be considered to disclose “a first media object targeted to a first user audience (or a first user profile)” and “a second media object targeted to a second user audience (or a second user profile)” to be “presented at an instance in the program,” as recited in independent claims 1, 26, and 52.

For the reasons set forth above, Flickinger does not disclose each and every feature of the claimed invention. Accordingly, independent claims 1, 26, and 52 are patentable under 35 U.S.C. §102(e) over Flickinger. Claims 2-16, 27-34, 53-57, 61-65, and 198, each of which depends from one of independent claims 1, 26 or 52, are likewise patentable under 35 U.S.C. §102(e) over Flickinger for at least the same reasons set forth above regarding the applicable independent claims. Accordingly, the anticipation rejections of pending claims 1-16, 26-34, 52-57, 61-65, and 198 are improper and should be withdrawn.

§103 Rejection of the Claims

Claims 58-60 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flickering in view of U.S. Patent No. 6,480,885 to Olivier. As discussed above, Flickinger does not disclose “a programming signal that comprises ... a portion of the plurality of targeted media objects to be presented at instance in the program” that includes “a first media object to be targeted to a first user profile and a second media object to be targeted to a second user profile,” as recited in independent claim 52. Applicants respectfully submit that the claims 58-60, each of which depends from independent claim 52, are not obvious over Flickering in view of Olivier. Applicants therefore respectfully request the Examiner to withdraw the 35 U.S.C. §103(a) rejections of pending claims 58-60.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4047 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to deposit account No. 19-0743.

Respectfully submitted,

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Date 10/15/2008

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of August, 2008.

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